SUPREME COURT, U. S.

FILED

MAY 3 1969

JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

October Term, 1968.

No. 1355

BLUMCRAFT OF PITTSBURGH, a Partnership Consisting of Hyman Blum, Max Blum, Louis Blum and Harry P. Blum,
Petitioners,

v.

CITIZENS AND SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, DANIEL CONSTRUCTION COMPANY, INC. and COLONIAL IRON WORKS, INC.,
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT.

JAMES C. MCCONNON,
HENRY N. PAUL, JR.,
PAUL & PAUL,
1815 Land Title Building,
Philadelphia, Pa. 19110

RALPH BAILEY, JR.,
BAILEY & DORITY,
125 Broadus Avenue,
Greenville, S. C. 29601

Attorneys for Petitioners.

International, 711 So. 50th St., Phila., Pa. 19143—Tel. SA 7-8711 Area Code 215

INDEX.

	Page
I. Orders, Opinions and Judgments Below	1
II. Statement of the Ground on Which Jurisdiction of This Court Is Invoked	2
III. Questions Presented for Review	2
IV. Statement of the Case	4
A. The History of the Case	4
B. Louis Blum's Inventions	5
C. Decisions of the Courts Below	6
V. Reasons for Granting the Writ of Certiorari	10
A. Direct Conflict Between Decisions of the Court of Appeals for the Fourth Circuit and the Court of Claims	10
B. Failure of the Court of Appeals for the Fourth Circuit to Meet the Minimal Demands of Comity Among Federal Courts: Conflict With Mast, Foos and Co. v. Stover Mfg. Co., 177 U. S. 485 (1900)	11
C. Direct Conflict Between Decisions Rendered by Different Panels of the Court of Appeals for the Fourth Circuit	16
D. Important Question as to the Construction of § 103 of the Patent Act	17
E. Important Question as to the Application of the Patent Act of 1952 to the Design Patent	19
VI. Conclusion	20

TABLE OF CASES CITED.

Page

American Air Filter Co. v. Continental Air Filters, Inc., 347 F. 2d 931, cert. denied 383 U. S. 934 (1966) 14

Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc., certiorari granted March 24, 1969, No. 1014, October Term, 1968 .....1, 17, 21

Blumcraft of Pittsburgh v. Architectural Art Mfg., Inc., No. W-4037, D. Kan. 1968, filed August 7, 1968 1

Blumcraft of Pittsburgh v. Citizens and Southern National Bank, 255 F. Supp. 441 (D. S. C. 1966) 4

Blumcraft of Pittsburgh v. The United States, 178 Ct. Cl. 798, 372 F. 2d 1014 (1967) 1, 9, 10, 16, 17

Calmar, Inc. v. Cook Chemical Co., 336 Fed. 110 (8th Cir. 1964) 17

Cincinnati Butchers' Supply Co. v. Walker Bin Co., 230 Fed. 453 (6th Cir. 1916) 14

John Deere Co. of Kansas City, et al. v. Graham, et al., 333 F. 2d 529, aff'd. 383 U. S. 1 (1965) 15, 17

General Motors Corp. v. Leishman, 65 F. Supp. 187 (S. D. Cal. 1949) 14

Glen Raven Knitting Mills v. Sanson Hosiery Mills, 189 F. 2d 845 (4th Cir. 1951) 19

Gorham Manufacturing Co. v. White, 81 U. S. (14 Wall.) 511 (1871) 19

Gormley & Jeffrey Tire Co. v. United States Agency, et al., 177 Fed. 691 (2d Cir. 1910) 14

Graham v. Cockshutt Farm Equipment, Inc., 256 F. 2d 358 (5th Cir. 1958) 15

Graham, et al. v. John Deere Co. of Kansas City, et al., 383 U. S. 1 (1965) 17, 18, 20

Hunt et al. v. Armour & Co., 185 F. 2d 722 (7th Cir. 1950) .. 14

Jeoffroy Mfg., Inc. v. Graham, 219 F. 2d 511 (5th Cir. 1955) 15

LaMaur, Inc. v. DeMert & Dougherty, Inc., 265 F. Supp. 961 (N. D. Ill. 1965) 14

TABLE OF CASES CITED (Continued).

Page

Mast, Foos and Co. v. Stover Mfg. Co., 177 U. S. 485 (1900) 11, 12, 13, 15, 16

Nickerson v. Kutschera, 390 F. 2d 812 (3rd Cir. 1968) 12

Novadel-Agne Corporation v. Penn et al., 119 F. 2d 764, cert. denied 314 U. S. 645 (1941) 14

Parsons Non-Skid Co. et al. v. E. J. Williams Co., 190 Fed. 333 (2d Cir. 1911) 14

Pavement Salvage Co., Inc. v. Anderson's-Black Rock, Inc., 4 Cir., 404 F. 2d 450, certiorari granted March 24, 1969, No. 1014, October Term, 1968 ..... 16, 21

Robertson Rock Bit Co., Inc. et al. v. Hughes Tool Co., 176 F. 2d 783, cert. denied 338 U. S. 948 (1950) 14

Schnell v. Peter Eckrich & Sons, Inc., 365 U. S. 260 (1961) 4

Smith v. Whitman Saddle Co., 148 U. S. 674 (1892) 19

Stoody Co. v. Osage Metal Co., Inc., 95 F. 2d 592 (10th Cir. 1938) 14

Technograph Printed Circuits, Ltd. v. Methode Electronics Corp., 285 F. Supp. 714 (N. D. Ill. 1968) 12

Technograph Printed Circuits, Ltd. v. Packard Bell Electronics Corp., 290 F. Supp. 308 (C. D. Cal. 1968) 12

Textile Mach. Works v. Louis Hirsch Textile Machines, Inc., 13 F. Supp. 476 (S. D. N. Y. 1936) 14

Triplett v. Lowell, 297 U. S. 638 (1936) 12

Warren Bros. Co. v. City of New York, 187 Fed. 831 (2d Cir. 1911) 13

Williams v. Hughes Tool Co., 186 F. 2d 278, cert. denied 341 U. S. 903 (1951) 14

STATUTES AND PERIODICALS CITED.

	Page
Act of May 9, 1902, Chapter 783, 32 Stat. 193	19
Blaustein, The Presidential Commission and the return to the Patent Act of 1753, 53 A. B. A. J. 911 (1967)	12
House of Representatives Bill HR-13951, November 9, 1967	12
Patent Reform Act of 1967, February 21, 1967	12
Senate Bill S-52597, October 30, 1967	12
28 U. S. C. § 1254	2
28 U. S. C. § 1338	2
35 U. S. C. § 103	9, 17, 18, 20
35 U. S. C. § 171	19

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioners, Blumcraft of Pittsburgh, a Partnership consisting of Hyman Blum, Max Blum, Louis Blum and Harry P. Blum, pray that a Writ of Certiorari be issued to review the Decision and Order of the Court of Appeals for the Fourth Circuit entered on February 19, 1969 and that this case be listed for argument to follow *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, cert. granted March 24, 1969, No. 1014, October Term, 1968.

I.

ORDERS, OPINIONS AND JUDGMENTS BELOW.

(a) Decision and Order of the Court of Appeals for the Fourth Circuit, Appeal No. 12719, February 19, 1969, not officially reported, unofficially reported at 160 U. S. P. Q. 642.

(b) Opinion and Order of the District Court for the District of South Carolina, May 29, 1968, 286 F. Supp. 448, 158 U. S. P. Q. 642 (1968).

(c) The patents here in suit are also before the United States District Court for the District of Kansas in the following case, as yet untried:

Blumcraft of Pittsburgh v. Architectural Art Mfg., Inc., No. W-4037, filed August 7, 1968.

(d) The design patent here in suit has also been adjudicated in the United States Court of Claims in

Blumcraft of Pittsburgh v. The United States, 178 Ct. Cl. 798, 372 F. 2d 1014 (1967).

II.

STATEMENT OF THE GROUND ON WHICH JURISDICTION OF THIS COURT IS INVOKED.

(a) This is a suit arising under the patent laws of the United States, Title 28 § 1338, of the United States Code.

(b) The jurisdiction of this Court is invoked under Title 28 § 1254 of the United States Code.

(c) The date of the Decree which the Petitioners seek to have reviewed herein is February 19, 1969. No petition for a rehearing was filed.

III.

QUESTIONS PRESENTED FOR REVIEW.

In 1954, the U. S. Patent Office issued a design patent to Petitioner for a unique ornamental railing design compatible with contemporary rather than traditional architectural styles. Also, in 1959, the U. S. Patent Office issued to Petitioner a patent on a unique mechanism for connecting a handrail in spaced relation to a post particularly adapted to the needs of modern architecture. The U. S. Government sought to use one of these patents without compensation to Petitioner. Upon suit in the Court of Claims the design patent was held valid and infringed and the Government did not seek review therefrom. This decision was cited with approval by another panel of the Court of Appeals for the Fourth Circuit. Respondents have used the same patents without compensation.

On essentially the same record and the same evidence as was before the Court of Claims the District Court independently held the design patent valid and infringed after finding as a fact that the design was novel and non-obvious. The District Court likewise held the mechanical patent valid and infringed. The Court of Appeals for the Fourth Circuit, however, without giving any weight whatsoever to

the Court of Claims decision, without resort to any evidence other than that in the earlier case and that presented at the contest in the Patent Office, reversed the District Court decision and held that both patents were invalid. The sole basis for its decision was that, even though the prior art did not reveal the novel subject matter of the patents, highly skilled persons could have redesigned the prior art to achieve the structures and designs set forth in the patents at issue. Therefore, the questions presented for review are:

(a) Did the Court of Appeals err in declaring the design patent invalid when it (a) basically accepted the District Courts' finding that the design was not obvious because unusual and contrary to any normal expectation, requiring considerable thought and substantial redesign of the prior art but, (b) went on, on a basis unsupported by the record, to conclude that persons highly skilled in the art could have redesigned the prior art to achieve the design?

(b) Did the Court of Appeals err by applying standards of patentability which conflict with § 103 of the Patent Act of 1952 and prior decisions of this Court?

(c) Did the Court of Appeals err by giving no consideration or weight whatsoever to the final adjudication of validity of the same patent by the U. S. Court of Claims, thus denying comity to a final decision of a coequal federal court?

(d) Should the doctrine of comity among federal courts be developed by this Court so as to limit the endless relitigation of the validity of a single U. S. patent in each of the Circuits producing contrary results on the same record?

IV.

STATEMENT OF THE CASE.

A. The History of the Case.

The present law suit began on September 27, 1962 as the result of controversy between Blumcraft of Pittsburgh, owner of the patents in suit, and Architectural Art Mfg., Inc., involving the infringement of Blumcraft's patents by ornamental railings advertised by Architectural Art. The suit was brought against the defendants, customers of Architectural Art, as statutory infringers, when the specific railings in suit were discovered, upon Architectural Art's refusal to admit the manufacture and sale of the railings it advertised.

Plaintiff attempted to have Architectural Art made a party defendant on the basis of Architectural Art's complete control of the defense and counterclaim in this case. After initially granting plaintiff's motion, the District Court reversed itself on the authority of *Schnell v. Peter Eckrich & Sons, Inc.*, 365 U. S. 260 (1961). *Blumcraft of Pittsburgh v. Citizens and Southern National Bank*, 255 F. Supp. 441 (D. S. C. 1966).[1]

The trial of the case began on May 17, 1967 and the District Court rendered its decision on May 29, 1968, holding both Blum patents valid and infringed. Upon defendants' appeal to the Court of Appeals, the case was argued on December 2, 1968 and on February 19, 1969 the Court of Appeals for the Fourth Circuit rendered its decision reversing the District Court on the issue of validity of each of the patents. The District Court's findings of infringement were not touched upon by the Court of Appeals. The Mandate of the Court of Appeals was stayed on March 19, 1969 to permit this petition to be filed.

---

1. The matter is somewhat confused by the Court of Appeals' treatment of Architectural Art as a party actually before the court (Appendix p. 47a, third paragraph).

B. Louis Blum's Inventions.

About sixty years ago, Hyman Blum, an ornamental iron worker who had served his apprenticeship as a boy in Russia, established his business in Pittsburgh, Pennsylvania. He made out of wrought iron the articles created by architects for use in monumental buildings. His three sons joined their father in his work. For more than forty years, Louis Blum has been personally responsible for the manufacture and even the design of many beautiful ornamental metal structures such as railings, grille work, communion rails and lighting fixtures. In the railing field his work initially followed the traditional patterns of ornamental railing design.

In 1952, Louis Blum was determined to develop a new and original railing which would be compatible in design with the growing number of monumental buildings being designed by architects using contemporary rather than traditional techniques. He created a railing design in which a plurality of rectangular vertical posts formed one plane and a plurality of flat horizontal rails formed a separate plane, parallel to the first plane, connected in a way to produce a visual floating effect. After twenty-five years of creative endeavor this was the first design for which he filed a patent application. He obtained his patent in 1954.

When the Blumcraft firm began marketing the new railing design it met with an immediate, astounding success. The business of the firm jumped 1700% within a period of five years. In the same period its payroll grew from eight or ten employees to between ninety and one hundred. These results were directly attributable to the ornamental and esthetic effect of Louis Blum's new railing design, especially upon architects who seized upon the design as one adapted for use with a myriad of contemporary buildings. As the Blumcraft design became successful, other manufac-

turers began copying it, including Architectural Art Mfg., Inc., an early customer of Blumcraft.

In 1956, Louis Blum perfected a unique mechanism for attaching a handrail in spaced relation to a post particularly adapted to the needs of modern architecture in that the connecting function was substantially minimized. This was accomplished by utilizing a dovetail-shaped base portion of the handrail in cooperation with a pair of V-shaped clamps which served to connect the rail to the posts, spacing the rails from the post and at the same time producing the rigidity and strength required in railing structures. In this mechanism, Louis Blum presented for the first time in the art a bracket in which the clamping function was integrated in the spacing connector element. This invention was also exceptionally well-received in the art and achieved considerable success and was also copied by Architectural Art.

C. Decisions of the Courts Below.

All of the expert witnesses who have testified either for or against Louis Blum's design patent and all of the courts that have judged it have agreed on one point: that Louis Blum did create an original railing design which had never been seen before and this design was ornamental and entirely compatible with modern architecture. Except for the Court of Appeals below, the design has been consistently found (by the seven judges of the Court of Claims and the trial judge in this case) to be characterized by the following distinctive features:

1. A plurality of spaced parallel posts generally rectangular in cross section and arranged so as to present a series of spaced parallel vertical surfaces;

2. A plurality of spaced parallel handrails generally flat or rectangular in cross section and arranged in the same vertical plane so as to present a series of parallel horizontal surfaces;

3. Connecting brackets attaching the underside of each handrail to the adjacent edge of each post, each bracket comprising a rod-like member extending at right angles to the post and a substantially flat triangular member extending upward from the rod-like member to the center of the underside of each rail leaving the rail unobstructed throughout the hand-gripping portion thereof;

4. The aforesaid elements so designed and arranged as to cause the handrails to appear to float in space away from the posts.

At the trial, the evidence developed Louis Blum's efforts to produce the design and its immediate impact upon the art. It was established through plaintiff's expert witness, Dean Henry L. Kamphoefner, architect and Dean of the School of Design at North Carolina State University that, beginning after the turn of this century, a modern school of architecture developed and grew in this country in which design was characterized by the elimination of rococo features and by the utilization of broad, straight lines and shaped surfaces and by the separation of planes and surfaces to produce dramatic visual effects entirely consistent with the functions of the articles themselves.

To satisfy the need for a railing in a building designed in accordance with modern principles, an architect was compelled to resort to commercial railings incompatible with modern architecture or to provide an individual railing on a job-by-job basis for each particular building design. There was no railing compatible with the requirements of contemporary design. The testimony established the significance of each of the distinctive features of the design in producing the overall visual effect and that the market impact of the railing design was based upon its esthetic appearance. Catalogs published by numerous competitive

manufacturers after the Blum design achieved its success showed the widespread adoption of all of the aforementioned distinctive esthetic features of the Blum design. No evidence was offered to show the imitation or adoption of a single one of the prior art railing designs.

Against Louis Blum's design patent the defendants amassed, in their own words, "a labyrinth of prior art" which was pieced together at the trial by their expert witness Clarence T. Fishleigh with the aid of charts and diagrams he had prepared. Plaintiff challenged both the testimony of Fishleigh and his exhibits. He was entirely lacking in any qualifications in the ornamental railing art and had nothing to do with the selection of the prior art and had no knowledge of it other than as it was presented to him by defendants' attorneys. The charts and diagrams were elaborate mosaics created by Fishleigh from separate pieces of prior art according to his own definition of Louis Blum's design. The prior art showed numerous manufactured railings with the rails intersecting the posts in the traditional manner. Presented as the closest prior art was the principal reference cited against the Blum application in the Patent Office which showed a plurality of parallel handrails intersecting round posts. The remaining prior art showed individual railings designed by architects for particular buildings in which a single rail was spaced apart from a supporting structure in the way that wall rails had been mounted for ages.

No prior art showed the design of the particular connecting brackets of the Blum railing nor did any prior art show a plurality of handrails spaced apart from a plurality of posts forming separate planes, presenting the opposed vertical and horizontal surfaces characteristic of Louis Blum's design. In contrast to the experience with the Blum railing design no prior art design was shown to have been used more than once, if at all, or by any person other than the one who made it.

The District Court found the design novel and non-obvious on the basis of 35 *U. S. C.* § 103. It also found that the testimony of the defendants' own expert strongly supported the conclusion of non-obviousness (Appendix p. 13a). The decision of the United States Court of Claims in *Blumcraft of Pittsburgh v. The United States, supra,* holding the Blum design patent valid, was found to be persuasive but the Court arrived at its own independent decision (Appendix p. 14a).

The Court of Appeals agreed that the Blum design was novel but reversed the District Court's finding of validity upon its own assumption that the differences between the design and the prior art were "minor" and that the substantial redesigning of the prior art the District Court found would be necessary to produce the Blum design could have been accomplished by the highly skilled architects and manufacturers engaged in ornamental railing design. The Court of Appeals further contended that the success of Louis Blum's railing and its impact upon the art were based solely upon the fact that it was a "prefabricated" railing system (Appendix p. 51a).

The novelty of the Blum mechanical patent was also established in the District Court and accepted by the Court of Appeals. The defendants challenged the validity of the two claims of the mechanical patent in suit on the basis of two ornamental railing references applied against one claim and a railroad track anti-creeping device applied against the other. Defendants' witness Fishleigh produced in court a model representing a combination of the prior art presented against Claim 1 of the patent but the District Court found in this hybrid structure strong and persuasive evidence that it would *not* have been obvious to one skilled in the art to make the suggested combination, considering that it required the creation of an entirely new element, found neither in the prior art nor even in the Blum patent.

The District Court found the railroad track anti-creeping device patent to be far removed from the ornamental railing art of the invention and not reasonably available as a source of inspiration or information to one skilled in that art (Appendix p. 25a).

The Court of Appeals did not comment on the evidence which the District Court had found persuasive but concluded that the prior art was sufficient to establish the obviousness of the Blum mechanical patent. The Court of Appeals, to support its conclusion, further resorted to the railroad track anti-creeping device patent as prior art most pertinent to the design of ornamental railings (Appendix p. 54a).

V.

REASONS FOR GRANTING THE WRIT OF CERTIORARI.

A. Direct Conflict Between Decisions of the Court of Appeals for the Fourth Circuit and the Court of Claims.

Louis Blum's design patent was held valid and infringed by the United States Court of Claims on a record substantially the same as the record in this case, *Blumcraft of Pittsburgh v. The United States, supra.* That case was tried before Commissioner Donald E. Lane of the Court of Claims during the week of September 9, 1965. In an opinion filed September 22, 1966 the Commissioner found Louis Blum's patent to be valid and infringed (Appendix p. 57a). The parties agreed upon a procedure for accounting and the Government filed no exceptions to the Commissioner's report. Upon review, the Court of Claims agreed with the Commissioner's findings, opinion and recommendations for conclusions of law and therefore did not require oral argument but rendered its per curiam opinion holding the patent valid and infringed February

17, 1967. The entire record of the Court of Claims trial was introduced in evidence in this case.

In the words of defendants' attorney, there was "direct collaboration" between him and the Government attorney in the Court of Claims case, however artfully concealed. As a result of such collaboration, all of the prior art used by the defendants in this case was given by their attorney to the Government in the Court of Claims case. Some of the defendants' deposition testimony in this case was introduced directly into evidence in the Court of Claims. The attack upon the validity of the design patent made by the defendants in this case, as might be expected, is the same attack that was made by the Government in the Court of Claims.

It is manifest from the opinion of the Court of Appeals and the District Court below that there is no significant difference between the record in the Court of Claims case and the record in this case. There is therefore an irreconcilable conflict between the Court of Claims and the Court of Appeals as to the validity of Design Patent No. D-171,963 that can only be resolved by the Supreme Court.[2]

B. Failure of the Court of Appeals for the Fourth Circuit to Meet the Minimal Demands of Comity Among Federal Courts: Conflict With Mast, Foos and Co. v. Stover Mfg. Co., 177 U. S. 485 (1900).

The Courts of Appeals have for some time been grappling with the problem of repetitious litigation of a single patent through several courts. The problem has been considered by the Presidential Commission on Patent Reform and has been the subject of proposed legislation

2. In a press release emanating from Architectural Art Mfg., Inc. published February 26, 1969 the decision of the Court of Appeals for the Fourth Circuit was characterized as "contrary" to the previous decision of the Court of Claims.

in Congress: Patent Reform Act of 1967, February 21, 1967; Senate Bill S-52597, October 30, 1967; House of Representatives Bill HR-13951, November 9, 1967.

A recent case and the proposed legislation involved attempts to limit patent litigation by precluding the patentee from relitigating a patent once held invalid. The Court of Appeals for the Third Circuit in *Nickerson v. Kutschera*, 390 F. 2d 812 (1968), suggested that the Supreme Court's ruling in *Triplett v. Lowell*, 297 U. S. 638 (1936), permitting unlimited relitigation of the validity of the patent, "was either wrongly decided or should no longer be given its customary close reading" but declined to apply a new and different doctrine in view of the pending legislation in Congress. More than one year has passed since that time and no further action has been taken by Congress. This approach has met resistance in Congress and elsewhere, *Blaustein, The Presidential Commission and the return to the Patent Act of 1753*, 53 A.B.A.J. 911 (1967), *Technograph Printed Circuits, Ltd. v. Methode Electronics Corp.*, 285 F. Supp. 714 (N. D. Ill. 1968), *Technograph Printed Circuits, Ltd. v. Packard Bell Electronics Corp.*, 290 F. Supp. 308 (C. D. Cal. 1968).

Completely apart from the *res judicata* or estoppel questions raised in *Triplett v. Lowell, supra*, and *Nickerson v. Kutschera, supra*, some inhibition upon the proliferation of patent litigation can be achieved by the application of a proper rule of comity among Federal Courts. In *Mast, Foos and Co. v. Stover Mfg. Co., supra*, the Court summarized the rule of comity:

> "It demands of no one that he shall abdicate his individual judgment, but only that deference shall be paid to the judgments of other coordinate tribunals. Clearly it applies only to questions which have been actually decided, and which arose under the same facts."

Comity has been applied to hold patents valid or invalid in numerous cases in which the courts have stated their responsibility consistent with the *Mast, Foos* decision:

> "'There can be no doubt that the doctrine of comity not only, but the orderly administration of justice, requires that the Circuit Court should adopt and and follow the decisions of the Circuit Courts of Appeals in other circuits than their own, rendered upon facts substantially identical. Any other rule would lead to confusion and injustice. Of course in such circumstances the defendant in patent causes may introduce new evidence of anticipation and may show that the facts on which infringement is based are essentially different from those in the adjudicated case. Such proof must carry conviction with it.'
>
> "Appellant's brief bitterly attacks this statement, but we understand it to be an accurate presentation of the law and find nothing in *Mast, Foos & Co. v. Stover Mfg.*, 177 U. S. 488, 20 Sup. Ct. 708, 44 L. Ed. 856, which calls for any different conclusion." *Warren Bros. Co. v. City of New York*, 2d Cir., 187 Fed. 831, 835 (1911).
>
> "We could not acquit this defendant of infringement without finding both of these courts to be in error; but while we doubtless have that power, under Mast v. Stover, 177 U. S. 488, 20 Sup. Ct. 708, 44 L. Ed. 856, yet its exercise could be justified only by that degree of certainty which amounts to a demonstration. We think it is our duty here to adopt the principle declared by Judge Lurton, speaking for this court in Penfield v. Potts, 126 Fed. 475, 478, 61 C. C. A. 371, when he said that 'a decent respect for the stability of judicial decisions and the proper regard for the security of property in patents' requires that prior decisions be fol-

lowed, 'unless convinced of a very palpable error in law or fact'." *Cincinnati Butchers' Supply Co. v. Walker Bin Co.*, 6 Cir., 230 Fed. 453, 454 (1916).

". . . the importance of securing uniformity in the law as administered in the several circuits in patent causes is so great that a decision of a court of coordinate jurisdiction should be followed by this court in every case where the questions presented can fairly be regarded as doubtful. Pratt v. Wright (C. C.) 65 Fed. 99; Enterprise Mfg. Co. v. Deisler, (C. C.) 46 Fed. 855." *Gormley & Jeffrey Tire Co. v. United States Agency et al.*, 2d Cir., 177 Fed. 691, 692 (1910).

"The decision of the Fifth Circuit . . . upon facts substantially identical . . . while not binding upon this court is strongly persuasive under the doctrine of comity." *Williams v. Hughes Tool Co.*, 186 F. 2d 278, 281 (1950), cert. den'd. 341 U. S. 903, pet. for reh. den'd. 341 U. S. 934, 2d pet. reh. den'd. 341 U. S. 956.

See also *American Air Filter Co. v. Continental Air Filters, Inc.*, 6 Cir., 347 F. 2d 931 (1965), cert. den'd. 383 U. S. 934; *Hunt et al. v. Armour & Co.*, 7 Cir., 185 F. 2d 722 (1950); *Robertson Rock Bit Co., Inc. et al. v. Hughes Tool Co.*, 5 Cir., 176 F. 2d 783, cert. den'd. 338 U. S. 938 (1949), pet. for reh. den'd. 340 U. S. 923 (1951), 2d pet. for reh. den'd. 340 U. S. 939 (1951). *Novadel-Agene Corporation v. Penn et al.*, 119 F. 2d 764, cert. den'd. 314 U. S. 645 (1941); *Stoody Co. v. Osage Metal Co., Inc.*, 10 Cir., 95 F. 2d 592 (1938); *Parsons Non-Skid Co. et al. v. E. J. Williams Co.*, 190 Fed. 333 (1911); *La Maur, Inc. v. DeMert & Dougherty, Inc.*, 265 F. Supp. 961 (1965); *General Motors Corp. v. Leishman*, 85 F. Supp. 187 (1949). *Textile Mach. Works v. Louis Hirsch Textile Machine, Inc.*, 13 F. Supp. 476 (1936).

In the present case the Court of Appeals for the Fourth Circuit failed to meet even the minimal demands of the rule of comity among Federal Courts. It paid no deference whatever to the judgment of the Court of Claims. It made no effort to distinguish the facts in the case, although the full record of the Court of Claims was in evidence and it made no suggestion that the Court of Claims had failed to apply the proper statutory provisions or appropriate rulings of the Supreme Court. The Court of Appeals merely reached a contrary conclusion without finding fault with the *ratio decidendi* of the Court of Claims. Contrast this with the treatment by the Court of Appeals for the Eighth Circuit in *John Deere Co. of Kansas City, et al. v. Graham, et al.*, 333 F. 2d 529, aff'd. 383 U. S. 1 (1965), of the prior decisions by the Court of Appeals for the Fifth Circuit in *Jeoffroy Mfg., Inc. v. Graham*, 219 F. 2d 511 (1955) and *Graham v. Cockshutt Farm Equipment, Inc.*, 256 F. 2d 358 (1958). In its opinion the Court of Appeals for the Eighth Circuit gave the precise reason for its inability to follow the prior ruling of the Fifth Circuit.

In the *Mast, Foos* decision, *supra*, at page 489, the Court states:

> "It is scarcely necessary to say, however, that when the case reaches this court we should not reverse the action of the court below if we thought it correct upon the merits, though we were of the opinion that it had not given *sufficient weight* to the doctrine of comity." (Emphasis ours.)

This statement implies that the action of a lower court *should* be reviewed to determine its correctness upon the merits where, on its face, it has given insufficient weight to the doctrine of comity. In this case, the Court of Appeals having given no weight to the doctrine of comity, under the

Mast, Foos ruling, certiorari should be granted to determine whether its decision on the merits was correct.

It is manifest that a stricter application of the doctrine of comity among Federal Courts in patent cases would serve to limit repetitious litigation of a single patent in several courts whether it is held valid or invalid.

C. Direct Conflict Between Decisions Rendered by Different Panels of the Court of Appeals for the Fourth Circuit.

On November 6, 1968 the Court of Appeals for the Fourth Circuit, reversing the judgment of the District Court for the Southern District of West Virginia, held United States Patent No. 3,055,280 valid. *Pavement Salvage Co., Inc. v. Anderson's-Black Rock, Inc.*, 4 Cir., 404 F. 2d 450, certiorari granted March 24, 1969, No. 1014, October Term, 1968. In reversing the District Court, the Court of Appeals emphasized the desirability of avoiding subjective hindsight evaluations of the prior art colored by the knowledge of the disclosure of the patent before the Court and indicated the usefulness of objective criteria of obviousness. In support of its position, the Court of Appeals cited with approval, *inter alia, Blumcraft of Pittsburgh v. The United States, supra.* In the present case a different panel of the Court of Appeals for the Fourth Circuit reversed the District Court's finding of validity of the very patent held valid by the Court of Claims in *Blumcraft of Pittsburgh v. The United States, supra.* There is thus presented a conflict within the Court of Appeals for the Fourth Circuit regarding the soundness of the decision of the Court of Claims in *Blumcraft of Pittsburgh v. The United States, supra.*

The Court of Appeals decision in *Pavement Salvage Co., Inc. v. Anderson's-Black Rock, Inc., supra,* was not

published prior to argument of the present case in the Court of Appeals. However, the decision was rendered several months prior to the decision in the present case with at least one Circuit Judge (Honorable Simon E. Sobeloff) sitting on both panels. Nonetheless, in reversing the District Court in the present case, no reference was made by the Court of Appeals to its prior decision in the *Pavement Salvage Co.* case, nor did it acknowledge the conflicting treatment of the Court of Claims decision in *Blumcraft of Pittsburgh v. The United States, supra.* There is thus presented a direct conflict between the two Court of Appeals decisions with respect to the manner in which the question of obviousness under § 103 of the Patent Act is to be determined and specifically with respect to the decision of the Court of Claims in *Blumcraft of Pittsburgh v. The United States, supra.*[3]

D. Important Question as to the Construction of § 103 of the Patent Act.

By granting the writ of certiorari in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc., supra,* this Court acknowledged both the importance and the timeliness of the questions presented. The same basic questions and the same special and important reasons for hearing them at this time are presented in this case.

The District Court in the present case followed all of the directions of the Supreme Court in *Graham v. John Deere Co., supra,* and at the same time applied the high standard of patentability established by prior decisions of the Supreme Court (Appendix p. 26a):

---

3. This is parallel to the situation in which the Court granted certiorari in *Graham v. John Deere Co., supra,* one panel of the Court of Appeals for the Eighth Circuit holding a patent valid in *Calmar, Inc. v. Cook Chemical Co.,* 336 Fed. 110 (1964) and a different panel holding a different patent invalid in *John Deere Co. v. Graham, supra.*

> "Had the Court concluded that the combination of elements was obvious to one having ordinary skill in the art, it would not hesitate to hold the patent invalid in view of *Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 (1950) . . ."
>
> * * *
>
> "The Court should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. For patents are to 'promote the progress of science and useful arts', Article I, § 8 of the Constitution. Their function is not to bestow monopoly."

The District Court thus made clear that it was applying the same strict test of patentability reflecting the prior decisions of this Court. The District Court found Louis Blum's design patent non-obvious on the basis of the prior art and upon the testimony of defendants' own expert witness Fishleigh attesting the unlikelihood of the Blum design in view of the normal requirements of the ornamental railing art. The validity of the mechanical patent was evidenced by the remoteness of the prior art and the demonstrated unlikelihood that anyone would combine the prior art, as suggested by the defendants, to produce the claimed invention.

The Court of Appeals, in reversing the District Court, was unable to find the inventions in the prior art. Without supporting evidence, the Court did not undertake to demonstrate that the invention was "obvious" as required by § 103 of the Patent Act but only that, because of their high skill, those who had produced the prior art could have redesigned it to achieve Louis Blum's inventions. The Court of Appeals thus ignored the warning of the Supreme Court in *Graham v. John Deere Co., supra,* at page 36, to "guard

against slipping into hindsight . . . and to resist the temptation to read into the prior art the teachings of the invention in issue".

E. Important Question as to the Application of the Patent Act of 1952 to the Design Patent.

The Court has not adjudicated the validity of a design patent in more than seventy-five years. *Gorham Manufacturing Co. v. White*, 81 U. S. (14 Wall.) 511, 524 (1871), *Smith v. Whitman Saddle Co.*, 148 U. S. 674, 677 (1892). The statute governing design patentability has been substantially changed twice during that time: May 9, 1902, Chapter 783, 32 Stat. 193; 1952, 35 *U. S. C.* § 171. While the courts have consistently held that design patents must meet a test of patentability the same as mechanical patents, they have also acknowledged that the application of the statutory tests to the ornamental features of a design requires consideration of factors peculiar to that subject matter. *Glen Raven Knitting Mills v. Sanson Hosiery Mills*, 189 F. 2d 845 (4th Cir. 1951). In *Smith v. Whitman Saddle Co., supra*, this Court rendered its most recent pronouncement:

> "The shape produced must be the result of industry, effort, genius or expense, and new and original as applied to articles of manufacture. *Foster v. Crossin*, 44 Fed. Rep. 62. . The exercise of the inventive or originative faculty is required, and a person cannot be permitted to select an existing form and simply put it to a new use any more than he can be permitted to take a patent for the mere use of a machine. *If, however, the selection and adaptation of an existing form is more than the exercise of the imitative faculty and the result is in effect a new creation, the design may be patentable.*" (Emphasis added.)

It is eminently clear that the "considerable thought and . . . substantial redesign" found by the District Court in this case to be required to produce the Blum design from the elements of the prior art more than satisfies this test (Appendix p. 12a). Even in the opinion of the Court of Appeals below it is not denied that Louis Blum's design is "more than the exercise of the imitative faculty and the result is in effect a new creation".

On the basis of the Court's long-standing decisions in design cases Louis Blum's design is patentable. The Court has held that it was not the intent of Congress by the Patent Act of 1952 to change the standard of invention. *Graham v. John Deere Co., supra.* However, the *Graham* case included no reference to any design patent or design patent case. It would accordingly be entirely appropriate for the Court to accept the present case for review to settle the application of the Patent Act of 1952 to design patents in the light of the Court's prior design patent decisions.

VI.

CONCLUSION.

The present case is submitted to the Court as a proper case for the issuance of the writ of certiorari which, it is recognized, is not a matter of right and only to be used where there are special and important reasons therefor. The several reasons set forth above in the aggregate present two compelling general reasons for this case being considered by the Supreme Court:

1. There are direct conflicts among the Courts on the question of patent validity specifically based upon disagreement as to the application of § 103 of the Patent Act and the Court's decision in *Graham v. John Deere*

Co., supra, to mechanical and design patents. Having granted certiorari in the *Anderson's-Black Rock, Inc.* case, the Court will be able to dispose of directly related important questions in this case.

2. This case affords a proper occasion for the Court to consider the vexing problem of multiple relitigation of a single patent and the limitation of such relitigation through the application of the Federal doctrine of comity.

Petitioners respectfully request that this petition for certiorari be granted and that this case be listed for argument to follow *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc., supra.*

Respectfully submitted,

JAMES C. MCCONNON,
HENRY N. PAUL, JR.,
PAUL & PAUL,

RALPH BAILEY, JR.,
BAILEY & DORITY,

Attorneys for Petitioners.